



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,837	01/29/2004	Keishi Matsumoto	12014-0025	2346

22902 7590 08/14/2006

CLARK & BRODY
1090 VERMONT AVENUE, NW
SUITE 250
WASHINGTON, DC 20005

EXAMINER

HEWITT, JAMES M

ART UNIT PAPER NUMBER

3679

DATE MAILED: 08/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/765,837	Applicant(s) MATSUMOTO ET AL.	
	Examiner James M. Hewitt	Art Unit 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/19/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/19/06 has been entered.

Claim Objections

Claims 1, 6-8 and 10 are objected to because of the following informalities:

In claim 1, lines 6-7, "the surface (of the lubricating coating)" lacks proper antecedent basis.

In claim 1, line 7, should "the lubricating coating" be "the lower lubricant layer"?

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3679

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamamoto et al (WO 01/16516 A1).

With reference to Yamamoto et al's disclosure in US Patent No. 6,679,526 B2, which corresponds directly to the WO/0116516 A1 reference, Yamamoto et al discloses with respect to claims 1, 6-8, 10 and 14, a threaded joint for steel pipes comprising a pin and a box each having a contact surface including a threaded portion and an unthreaded metal contact portion and which has a lubricating coating on the contact surface, wherein the lubricating coating comprises a lower (radially inward) lubricant layer comprising a semi-solid or viscous rust-preventing film or oil (liquid between 0 and 40 degrees Celsius) atop an upper lubricant layer on the surface of the lubricating coating comprising a resin (solid at 40 degrees Celsius) in the form of a powder (see col. 6, ll. 23-42 and claim 5). The lower layer may comprise a basic metal salt of an organic acid (see col. 17, ll. 10-43). At least one of the pin and box are subjected to a chemical conversion surface treatment (see col. 13, ll. 49-69 and col. 14, ll. 36-45). The lower layer may also include alkali metal salts and alkaline earth metal salts, acids, alcohols, waxes, oils (see col. 18, ll. 10-56).

With respect to claim 2-5, 9, 11-13 and 15, the coating is a mixture of a lubricating oil and a wax, and may also include alkali metal salts and alkaline earth metal salts, acids, alcohols, oils. Refer to col. 6, ll. 23-42, claim 5 and col. 18, ll. 10-56.

At least one of the pin and box are subjected to a chemical conversion surface treatment (see col. 13, ll. 49-69 and col. 14, ll. 36-45).

Regarding claims 5 and 11-12, the method of forming the device is not germane to the issue of patentability of the device itself.

Claims 2-5, 9, 11-13 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Goto et al (US 6,869,111 B2).

Goto et al discloses a threaded joint for steel pipes which comprises a pin and a box each having a contact surface including a threaded portion and an unthreaded metal contact portion and which has a lubricating coating on the contact surface of at least one of the pin and the box, wherein the lubricating coating is semi-solid or solid at 40 degrees Celsius and is formed of a mixture comprising a lubricating oil (viscous basic metal salt of an organic acid; see col. 6 ll. 49 – col. 8 ll. 40) which is liquid in the temperature range of above 0 degrees Celsius and below 40 degrees Celsius and a wax (see col. 9, ll. 15-60) which is solid at 40 degrees Celsius. The coating may also include alkali metal salts and alkaline earth metal salts, acids, fats, alcohols, oils (col. 9, ll. 15-60). At least one of the pin and box are subjected to a chemical conversion surface treatment (col. 15, ll. 13-63).

Regarding claims 5 and 11-12, the method of forming the device is not germane to the issue of patentability of the device itself.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art

Art Unit: 3679

under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Response to Arguments

Applicant's arguments filed 5/19/06 have been fully considered but they are not persuasive.

With respect to the rejection of claim 1 by Yamamoto et al (hereinafter "Yamamoto"), the Examiner believes that Applicant attempts to assert that Yamamoto does not disclose that the upper lubricant layer appears on the surface of the lubricating coating, which is what is required by claim 1. The Examiner disagrees. Yamamoto's lubricating coating is comprised of two layers. The claimed upper layer (6) is between the lower layer (12) and the pin or box. The upper layer (6) appears or is disposed on a (the) surface of the coating insofar as it is in contact with a surface of the lower layer (12), which itself constitutes the, or part of the lubricating coating.

With respect to the rejection of claim 2 by Yamamoto et al (hereinafter "Yamamoto"), Applicant asserts that Yamamoto does not disclose that the lubricating coating is semi-solid or solid at 40°C and is formed of a mixture consisting essentially of a lubricating oil which is liquid in the temperature range of above 0°C and below 40°C and a wax which is solid at 40°C. The Examiner disagrees. In col. 17, ll. 4-8, the components of a rust preventing oil composition forming a rust preventing film according

Art Unit: 3679

to the fifth and sixth inventions are said to be described up to col. 18, line 56. FIG. 9 is said to correspond to the fifth invention and FIG. 10 is said to correspond to the sixth invention. The film is comprised of a metal salt of a carboxylic acid and a lubricant (a mixture of graphite, molybdenum disulfide, and an organic molybdenum compound). The film is said to be in the form of a semi-solid or a solid at room temperature (see col. 6, ll. 27-30). The oil composition also can comprise a wax (see col. 18, ll. 26-31). The composition thus comprises a mixture of an oil and a wax.

With respect to the rejection of claim 2 by Goto et al (hereinafter "Goto"), Applicant asserts that Goto does not disclose that the lubricating coating is semi-solid or solid at 40°C and is formed of a mixture consisting essentially of a lubricating oil which is liquid in the temperature range of above 0°C and below 40°C and a wax which is solid at 40°C. The Examiner disagrees. Goto discloses that the lubricating coating comprises is semi-solid or solid at 40 degrees Celsius and is formed of a mixture comprising a lubricating oil (viscous basic metal salt of an organic acid; see col. 6 ll. 49 – col. 8 ll. 40) which is liquid in the temperature range of above 0 degrees Celsius and below 40 degrees Celsius and a wax (see col. 9, ll. 15-60) which is solid at 40 degrees Celsius. The viscous metal salt is a viscous fluid at room (operating) temperature. A resin is not essential to the composition (note that the amount of resin present can range from 0-30%). The amounts of each of the components in the lubricating coating composition is not particularly limited so long as galling resistance and rust prevention is maintained.

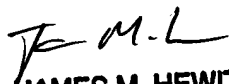
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James M. Hewitt whose telephone number is 571-272-7084.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Stodola can be reached on 571-272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMH
8/6/06


JAMES M. HEWITT
PRIMARY EXAMINER